

REMARKS

The Applicant has carefully reviewed and considered the Examiner's Action mailed November 15, 2004 in which claims 4 and 6-8 were withdrawn as being directed to a non-elected species. Elected Species I clearly shows a carrier with "recesses [7,8] inside which the cutting teeth [5] are mounted" (original claim 6). Thus, it is believed that claim 6 should be considered as readable on the elected species. Reconsideration is respectfully requested in view of the comments set forth below.

By this Amendment, claim 5 is rewritten in independent form and amended to recite a book conveying and notching device with structure for conveying the book along a path, as suggested by the Examiner in paragraph 2 of the Action. Accordingly, claims 1-9 are pending in the instant application with claims 4 and 7-8 withdrawn as being elected to a non-elected species.

The Action objected to claim 5 because of the informality described in page 2 of the Action. The foregoing amendments to claim 5 adopt the Examiner's suggestion and rewrite claim 5 in independent form. Accordingly, the objection to claim 5 should be overcome and withdrawal of the objection is respectfully requested.

Claims 1, 3, 5 and 9 were rejected under §102(b) as being anticipated by U.S. Patent No. 4,408,780 to Detterman et al. (hereinafter referred to as "Detterman") as explained in paragraph 4 of the Action. Claims 1-3 and 9 were rejected under §102(b) as being anticipated by U.S. Patent No. 296,757 to Kraushaar for the reasons set forth in paragraph 5 of the Action. These rejections are respectfully traversed.

As explained in the Summary of the Invention, the claimed invention provides a device for notching the spine of a book block formed with compressed signatures, which

improves the adherence of the glued to the spine of the book block, as well as the clamping effect of the book block spine. This is achieved with a notching tool that rotates around a pivot and is positioned approximately perpendicularly to a book block spine, where the notching tool is provided with a carrier, defining a circular cutting plane; and at least two cutting teeth **arranged opposite each other relative to the pivoting axis** and which are positioned at an acute angle to a circular cutting plane. As a result, a notching pattern structure can be realized in the book block spine that noticeably improves the rigidity and clamping effect of a book block spine.

In contrast attached to the claimed invention, Detterman discloses a notch cutter that provides a plurality of right-angled notches (see column 3, lines 4-11 of Detterman). The Action simply states that Detterman “shows a book notcher with an acutely angled blade as seen in figure 9” (Page 3, paragraph 4., lines 2-3 of the Action). The recited invention of claims 1 and 5 requires a notching tool that rotates around a pivot and includes 1) a carrier, defining a circular cutting plane; and 2) at least two cutting teeth attached to and projecting from the front of the carrier, **wherein the cutting teeth are positioned on opposite sides of the carrier relative to the pivot and are oriented at an acute angle β to the circular cutting plane, the teeth cutting into the book block spine to produce arc-shaped notches**. While Detterman does describe a notcher plate 51 attached to the upper end of a shaft 50 in column 4, lines 46-56 and Figure 8 and 9 of Detterman, Detterman fails to disclose at least two cutting teeth attached to and projecting from the front of the notcher plate wherein the cutting teeth are positioned on opposite sides of the notcher plate relative to the pivot and are oriented at an acute angle β to the notcher plane so that the teeth cut into the book block spine to produce arc-

shaped notches, as recited in independent claim 1. The blade sets 53, 54, 55 disclosed by Detterman are one after the other and not arranged on opposite sides of notcher plate 51. Detterman illustrates three sets of notching blades in Fig. 8; however, each set does the desired notching of a book block spine. Nowhere does Detterman describe a blade of one set working with a blade of another set positioned on the opposite side of the shaft 50.

More to the point, nowhere does Detterman describe that its blades are oriented at an acute angle β to the notcher plate 51 and nowhere does Detterman describe that its blades produce arc-shaped notches as recited in claim 1. Instead, Detterman describes blades 53-58, which for notches that have exclusively perpendicular and/or parallel side walls. The fact that Detterman describes notcher plate 51 as being placed at a small angle to the vertical (column 4, lines 46-49 of Detterman) cannot anticipate the recited blades being at an acute angle to the carrier. Thus, Detterman cannot anticipate the claimed invention because it at least fails to disclose 1) cutting teeth positioned on opposite sides of the carrier relative to the pivot and that are oriented at an acute angle β to the circular cutting plane, and 2) the teeth cutting into the book block spine to produce arc-shaped notches. Accordingly, Detterman cannot anticipate claims 1,3,5 and 9 because it fails to disclose each and every recited feature of the claimed invention.

Kraushaar is directed to a vegetable slicer that has an inwardly angled blade and an outwardly angled blade. Kraushaar describes a device that rapidly cuts or shreds kraut with a revolving disk provided with flat knives. The cut or shredded kraut falls through openings in the disk into a receptacle below. The Action states that “a book placed in [Kraushaar’s] device would undoubtedly get notched, and thus Kraushaar passes the capability test.” See paragraph 5., lines 3-5 of the Action. It is respectfully submitted that

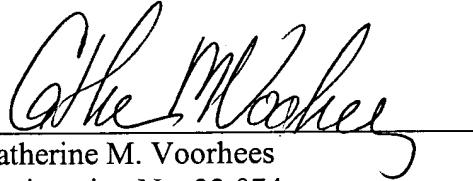
the capability test should be toward a book being conveyed and being notched with an arc-shaped pattern. Kraushaar's **two angled blades 2 on the same side of the pivot** may cut or shred a book, but not produce the recited arc-shaped notches of claims 1. In addition, if a book can fit in a receptacle *a*, Kraushaar's device would not allow a book block to pass by the blades along a conveying path for a perfect binder, as recited in the preamble of claim 1. Consequently, Kraushaar's device would not be able to produce arc-shaped notches in a conveyed book block spine. Accordingly, claims 1-3 and 9 cannot be anticipated by Kraushaar.

In that neither Detterman nor Kraushaar fails to disclose each and every element of claimed invention including the "wherein" clause, the prior art of record cannot anticipate claims 1-3, 5 and 9 of the present invention. Accordingly, it is respectfully submitted that independent claims 1 and 5, and dependent claims 2-3, 6 and 9 are allowable over the prior art of record. Reconsideration of the application, withdrawal of the rejections of record, rejoinder of non-elected species (claims 4-5 and 8) and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner believe that a conference would advance the prosecution of this application, the Examiner is encouraged to telephone the undersigned counsel to arrange such a conference.

Respectfully submitted,

Date: May 16, 2005



Catherine M. Voorhees
Registration No. 33,074
VENABLE LLP
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 344-4000
Telefax: (202) 344-8300

CMV/elw
DC2/648093

In the Drawings:

Please add new Figure 8 that shows the device with teeth of different lengths, as set forth in claim 8.

Attachment: Fig. 8